

Remarks

Claims 1, 3-9, 11-21, 23-25, 28-31, 33, 35-41, 43-49, 51, 53-66, 69-78, 80-90, 92-93, and 95-113 are in the application. Claims 1, 33, 63, 65, 66, 78, 102, and 108 are in independent form. Reconsideration is requested.

Claims 1, 3-9, 11-21, 23-25, 28-31, 33, 35-41, 43-49, 51, 53-66, 69-78, 80-90, 92-93, and 95-113 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The Examiner submits that the term “not being in wired communication” lacks sufficient support in the specification. Applicants respond as follows.

The passage to which the Examiner objects states “the one or more output devices and the wireless mobile information apparatus not being in wired communication with each other.” Wired and wireless communication are distinguished at paragraph [0006] of the application:

Conventionally, an output device (e.g., a printer) is connected to an information apparatus via a wired connection such as a cable line. A wireless connection is also possible by using, for example, radio communication or infrared communication.

Paragraph [0109] of the specification states that “information apparatus 100 may communicate via a wired or wireless connection with output controllers 120 that are connected to or included in output devices 140.” Paragraph [0111] of the specification states that:

In one scenario, information apparatus 100 broadcasts a service request, for example printing, through wired or wireless signals. Service devices, such as output device 140 equipped with output controller 120, “listen to” such signals, “read” the request, “see” whether they can provide requested service, and respond if they can provide the requested service.

Paragraph [0112] further states that “various protocols may be implemented in the discovery process 502. Wireless communication protocols are preferred. Wired communication, on the other hand, may also be implemented.”

A rejection under 35 USC 112, first paragraph, for failure to comply with the written description requirement is improper and should be withdrawn if the subject matter is described in the application in such a way as to reasonably convey to one skilled in the art that the applicant had possession of the claimed subject matter at the time the application was filed. The specification states that an information apparatus and an output device of the present invention "may communicate via a wired or wireless connection" and that "information apparatus 100 broadcasts a service request, for example printing, through wired or wireless signals." (Specification, paragraph [0109] and paragraph [0111].) Paragraph [0112] the application states that "wireless communication protocols are preferred. Wired communication, on the other hand, may also be implemented."

Wired communication is different from wireless communication. (Paragraph [0006].) The specification clearly and repeatedly states that an information apparatus may communicate with an output device by wired or wireless communication. (Paragraphs {0109}, [0111], and [0112].) Applicants submit, therefore, that the specification clearly conveys to a person of skill in the art at the time the application was filed an implementation in which an information apparatus is not in wired communication with an output device. In fact, the specification states that wireless communication is preferred over wired communication. Applicants submit, therefore, that the rejection under 35 USC 112, first paragraph, for failure to comply with the written description requirement is improper and should be withdrawn.

In the absence of any rejection over a cited reference, applicants submit that withdrawal of the rejection under 35 USC 112, first paragraph, would place claim 31 in condition for allowance.

Claims 1, 3-5, 7-9, 11-21, 23-25, 29-30, 33, 35-37, 39-41, 51, 53-55, 69-74, 76-78, 92-93, and 95-113 are rejected under 35 USC 102(e) for anticipation by Atkinson et al. (2002/0012329) (hereafter Atkinson). Claims 6, 28, 38, 56, 57, 75, and 85 are rejected under 35 USC 103(a) for obviousness of Atkinson in view

of Naito (US Pat. No. 6,628,417). Applicants traverse these rejections for the following reasons.

The Atkinson application was filed May 4, 2001, which is after the November 1, 2000 filing date of provisional application no. 60/245,101 to which the present application claims benefit under 35 USC 119(e). Atkinson is prior art to the present application only if subject matter relied upon by the Examiner in the rejection has an effective filing date earlier than November 1, 2000. However, as indicated below, subject matter relied upon by the Examiner in the rejection has an effective filing date after November 1, 2000. As a consequence, Atkinson is not prior art to the present application and the rejections should be withdrawn.

The Atkinson application is the culmination of a chain of ten provisional patent applications, as indicated by the Related US application data for Atkinson:

This Application is related to and claims priority from the following commonly assigned Applications: Provisional Application Ser. No. 60/224,701, filed Aug. 11, 2000; Provisional Application 60/227,878, filed Aug. 25, 2000; Provisional Application 60/243,654, Oct. 26, 2000; Provisional Application 60/250,928, filed Dec. 1, 2000; Provisional Application 60/254,595, filed Dec. 11, 2000; Provisional Application Ser. No. 60/208,967, filed Jun. 2, 2000; Provisional Application Ser. No. 60/220,047, filed Jul. 21, 2000; Provisional Application 60/239,320, filed Oct. 10, 2000; Provisional Application Ser. No. 60/267,555, filed Feb. 9, 2001; and Provisional Application 60/271,607, filed Feb. 26, 2001.

Provisional Application 60/243,654

The Examiner cites paragraph [102] of Atkinson as disclosing various features recited in the claims. Paragraph [102] of Atkinson provides the only description of Fig. 10 of Atkinson. A drawing similar to Fig. 10 of Atkinson is first included in provisional application 60/254,595, filed Dec. 11, 2000, after the November 1, 2000 effective filing date of the present application. There is no description in the '595 provisional application corresponding to paragraph [0102] of the Atkinson application. The subject matter of paragraph [102] and associated Fig. 10 of the Atkinson application are first included together in provisional application 60/271,607, filed Feb. 26, 2001, which is also after the

November 1, 2000 effective filing date of the present application. The subject matter of paragraph [102] of the Atkinson application corresponds to page 39 of the '607 provisional application, and associated Fig. 10 corresponds to page 51.

All the rejections of the present application rely on paragraph [102] and associated Fig. 10 of the Atkinson patent application. Fig. 10, with no associated description, was first included in a provisional application dated December 11, 2000, and subject matter corresponding to paragraph [102] first included in a provisional application dated February 26, 2001. None of the subject matter of paragraph [102] of Atkinson forming the basis of the Examiner's rejections has an effective filing date earlier than the November 1, 2000 effective filing date of the present application. Applicants submit, therefore, that Atkinson is not prior art to the present application and that all rejections over Atkinson are improper and should be withdrawn.

Applicant believes the application is in condition for allowance and respectfully request the same.

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